

## REMARKS

Claims 1–3, 10, 12–19, 21–40, 42–50 and 60 are pending.

### Rejections under 35 U.S.C. § 103

Obviousness is a question of law based on underlying factual inquiries set forth in *Graham v. John Deere*: (1) determining the scope and content of the prior art; (2) ascertaining the differences between the claimed invention and the prior art; and (3) resolving the level of ordinary skill in the pertinent art. Objective evidence of non-obviousness must be also considered. In assessing the differences between the claim and the cited references, every feature of the claim must be disclosed or suggested in the cited references or known to one skilled in the art in making a *prima facie* case of obviousness. *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003). A *prima facie* case of obviousness also requires a reasonable expectation of success in the modification or combination of references, which must be found in the cited references or must be known to one skilled in the art. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Claims 1, 12, and 31–36 stand rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 6,350,278 (Lenker) in view of U.S. Patent No. 6,626,919 (Swanstrom). Swanstrom does not qualify as prior art to the present application. Swanstrom issued on September 30, 2003. The present application was filed on January 16, 2002. Consequently, Swanstrom does not qualify as prior art under either 35 U.S.C. §§ 102(a) or 102(b). With respect to 35 U.S.C. § 102(e), Swanstrom was not filed by “another” as required under 35 U.S.C. § 102(e)(2). The applicant in both Swanstrom and the present application is Lee L. Swanstrom. Consequently, Swanstrom also does not qualify as prior art under 35 U.S.C. § 102(e). For at least this reason, Applicant requests the Examiner withdraw the rejection.

Claims 2, 15, 24, and 25 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Lenker in view of Swanstrom and U.S. Patent No. 4,728,328 (Hughes). As discussed above, because Swanstrom does not qualify as prior art to this application, the rejection should be withdrawn for at least this reason.

Claims 3 and 16–19 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Lenker in view of Swanstrom, Hughes, and U.S. Patent Publication No. 2003/0023301 A1 (Cox). As

discussed above, Swanstrom does not qualify as prior art, and the rejection should be withdrawn for at least this reason.

Claims 10, 13, 14, and 60 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Lenker in view of Swanstrom and U.S. Patent No. 6,537,296 (Levinson). Because Swanstrom does not qualify as prior art, Applicant requests withdrawal of this application for at least this reason.

Claims 21–23 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Lenker in view of Swanstrom, Hughes, and U.S. Patent No. 5,653,745 (Trescony). Applicant requests the Examiner withdraw the rejection because Swanstrom does not qualify as prior art, as discussed above.

Claims 26 and 27 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Lenker in view of Swanstrom, Hughes, and U.S. Patent No. 6,248,116 (Chevillon). Because Swanstrom does not qualify as prior art, as discussed above, Applicant requests the Examiner withdraw the rejection.

Claims 28–30 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Lenker in view of Swanstrom, Hughes, and U.S. Patent Publication No. 2006/0015176 A1 (White). Applicant requests the Examiner withdraw the rejection at least because Swanstrom does not qualify as prior art as discussed above.

Claims 37–39 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Lenker in view of Swanstrom and U.S. Patent No. 5,201,743 (Haber). Applicant requests the Examiner withdraw the rejection at least because Swanstrom does not qualify as prior art.

Claims 40 and 45–50 stand rejected 35 U.S.C. § 103(a) as unpatentable over Lenker in view of Cox. Independent claim 40 recites in part “means for urging said peripheral struts to a bowed state”. The Examiner relies on Lenker as disclosing this feature, stating in section 10 of the Office Action “Lenker disclose urging mechanism (350) that is capable of urging the struts into a bowed state when pulled back against the struts (342)”, relying on the embodiment illustrated in FIG. 23B. One skilled in the art would have no reasonable expectation of success in the hypothetical scenario proposed by the Examiner.

The Examiner acknowledges that Lenker does not *actually* disclose that pulling back the shaft 350 urges the axial members 342 to bow. Instead, the Examiner relies on a supposition that pulling back the shaft 350 *is capable of* urging the axial members 342 to bow. In fact, the axial

members **342** of Lenker resist bowing under the conditions of use, contrary to the Examiner's hypothesis. The axial members **342** maintain the prosthesis **P** in a radially compressed state in the configuration illustrated in FIG. **23A**. Lenker at Abstract ("The prosthesis is carried over the distal end of the shaft where it is contained in a radially compressed configuration by the sheath."). In the radially compressed state, the prosthesis **P** exerts a radial force on the axial members **342**, which would tend to urge the axial members **342** into bowed states in the configuration illustrated in FIG. **23A** if they were so inclined; however, the axial members **342** are not bowed in FIG. **23A**. Consequently, the axial members **342** resist bowing from the axial force exerted by the prosthesis **P**.

Moreover, the Examiner proposes replacing the prosthesis **P**, disposed within the axial members **342**, with a stent **10** of Cox disposed around the exterior of the axial members **342**. Unlike the prosthesis **P**, the stent **10** is not self-expanding. Consequently, the axial members **342**, which already resist bowing as discussed above, must now overcome radial resistance from the stent **10**. Furthermore, any bowing of axial members **342** will no longer be assisted by the compressed prosthesis **P**, which is removed under the Examiner's hypothetical scenario.

Those skilled in the art would also understand that an axial force needed to bow the axial members **342** is much greater than a radial force due to the triangle of forces. Consequently, the force required to initiate bowing by pulling the shaft **350** backwards as suggested by the Examiner is many times greater than a radial force applied at the midpoint of the axial members. As discussed above, the radial force applied by the prosthesis **P** is insufficient to bow the axial members **342**. Accordingly, the axial force needed for bowing the axial members **342** is many times greater than the radial force applied by the prosthesis **P**. One skilled in the art would not understand the retaining structure **340** as suitable for applying the required forces. For at least these reasons, one skilled in the art would have no reasonable expectation of success in the combination proposed by the Examiner.

Claim 40 also recites in part "means for urging said peripheral struts to a bowed state, wherein said peripheral struts expand radially outwardly from said longitudinal axis, to thereby dilate said surgical implant." The Examiner relies on FIG. **23B** for disclosing dilating the prosthesis **P**. The Examiner refers FIG. **23B** as illustrating the axial members **342** in a relaxed state, however. In fact, Lenker does not disclose or suggest the axial members **342** dilating the prosthesis in a bowed state as recited in claim 40.

For at least the above reasons, claim 40 is allowable over the cited references. Because claims 42-50 are dependent on claim 40, these claims are also allowable as dependent on an allowable base claim.

**No Disclaimers or Disavowals**

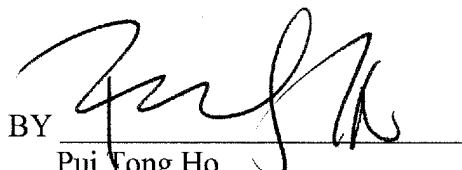
Any characterizations of claim scope or referenced art have been made to facilitate prosecution of this application. Applicants reserve the right to pursue any previously pending, or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or in any prior prosecution. Accordingly, reviewers of this or any parent, child, or related prosecution history shall not reasonably infer that Applicants have made any disclaimers or disavowals of any subject matter supported by the present application.

**Conclusion**

Applicants submit that all of the Examiner's rejections have been addressed and overcome, and that all claims are allowable over the art of record. Applicants have submitted amendments and arguments believed to be sufficient to overcome all of the outstanding rejections. Consequently, Applicants have not advanced every argument for the allowability of the claims over the references of record. As such, Applicants do not acquiesce to any of the Examiner's statements or characterizations not specifically traversed. Should the Examiner believe that any outstanding issues are resolvable in an Examiner's Amendment, the Examiner is invited to contact the undersigned.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 01-2215.

Respectfully submitted,  
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